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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,372	04/13/2007	Jozef Frans Nelissen	5100-000032/US	9863

30593 7590 11/09/2009
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EXAMINER

HAWTHORNE, OPHELIA ALTHEA

ART UNIT	PAPER NUMBER
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3772

MAIL DATE	DELIVERY MODE
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11/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/567,372	Applicant(s) NELISSEN, JOZEF FRANS	
	Examiner OPHELIA HAWTHORNE	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 - 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 - 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This action is in response to amendments/arguments filed on 08/11/09. Currently, claims 13 – 25 are pending in the instant application. Claims 26 -27 are newly added.

Response to Arguments

Applicant's arguments with respect to claims 13 - 25 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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1. Claims 13 and 17 – 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable of claims 1 – 14 of copending Application No. 11/902,264. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims of the instant application are obvious variants of the copending application. Claim 13 of the instant application recites a device for treating breathing problems, comprising a lower shaped part fitting onto the teeth of the lower jaw, an upper shaped part fitting onto the teeth of the upper jaw, and at least one adjustable connecting means between the upper and lower shaped part for forward/backward and upward/downward adjustment of the upper shaped part relative to the lower shaped part, wherein one shaped part of said upper and lower shaped parts is provided at the front with a slide mechanism including a slide element which is slidable laterally to a limited extent along a guide element, the at least one adjustable connecting means has a first end and a second end, said first end fixedly connected to the front side of the other shaped part of said upper and lower shaped parts such that said first end is in front of the teeth when said other shaped part is placed in the mouth, and said second end being connected to the slide element; the at least one adjustable connection means includes a horizontal adjusting screw for forward/backward adjustment of said shaped part relative to said other shaped part, a vertical adjusting screw for the upward/downward adjustment of said one shaped part relative to said other shaped part, and a coupling piece for coupling said horizontal screw with said vertical adjusting screw. Claims 1 - 3 and 7 - 8 of Application (264) recites a device for treating breathing problems, comprising: a first

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shaped part fitting onto the teeth of the lower jaw, having a front side located before the teeth, a second shaped part fitting onto the teeth of the upper jaw, having a front side located before the teeth, adjustable connecting means between the first and second shaped part for adjustment of the first shaped part relative to the second shaped part, said adjustable connecting means having a first end being fixedly connected to the one of said first and second shaped parts, and a second end being provided with a hook-like element, a guide element for said hook-like element, said guide element being provided at the front side of the other shaped part, wherein the hook-like element and the guide-element are arranged for allowing coupling to each other when the hook-like element is brought substantially in front of the guide element, so that in the coupled position both the guide-element and the hook-like element are situated in front of the shaped parts; wherein the adjustable connecting means are arranged for a forward/backward and upward/downward adjustment of the first shaped part relative to the second shaped part and wherein the adjustable connection means comprise a horizontal adjusting screw having a First and a second outer end, for forward/backward adjustment of the one shaped part relative to the other, said screw being connected by means of a connecting piece with adjustable connection means for the upward/downward adjustment and wherein the guide element is arranged for allowing a limited movement of the hook-like element along the guide element in a lateral direction substantially parallel to the front side of the other shaped part. At the time of the invention, the upper and lower shaped parts provided at the front with a slide mechanism including a slide element which is slidably laterally to a limited extent along a guide element of the instant application and

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one of the shaped parts provided with a slide mechanism consisting of a hook-like element which is slidably laterally to a limit extent along a guide element wherein the guide element is arranged for allowing limited movement of the hook-element in a lateral direction substantially parallel to the front side of the other shaped part of Application (264) would have been obvious variants of each other.

With respect to claim 17 of the instant application, all of the claim limitations are found in claim 1 of application '264 which discloses wherein the hook-like element and the guide element are arranged for allowing coupling to each other.

With respect to claim 18 of the instant application, all of the claim limitations are found in claim 4 of application '264.

With respect to claim 19 of the instant application, all of the claim limitations are found in claim 12 of application '264.

With respect to claim 20 of the instant application, all of the claim limitations are found in claim 13 of application '264.

With respect to claim 21 of the instant application, all of the claim limitations are found in claim 10 of application '264.

With respect to claim 22 of the instant application, all of the claim limitations are found in claim 5 of application '264.

With respect to claim 23 - 24 of the instant application, all of the claim limitations are found in claim 6 of application '264.

With respect to claim 25 of the instant application, all of the claim limitations are found in claim 14 of application '264.

With respect to claim 26 of the instant application, all of the claim limitations are found in claims 8 - 9 of application '264.

With respect to claim 27 of the instant application, all of the claim limitations are found in claims 8 – 9 of application '264.

2. Claim 14 of the instant application recites wherein the dimensions of the guide element and the slide element are closely-sized transversely of the guiding direction. At the time of the invention, it would have been obvious to one of ordinary skill in the art to adjust the dimensions of the guide element (50) and the slide element (48) in a closely-sized transverse direction (Fig. 7) as taught by Halstrom according to the comfort level of the user.

3. Claim 15 of the instant application recites wherein the guide element is a rod mounted between two points of the one shaped part, and the slide element is a hollow tube slidable around this rod. At the time of the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the guide and slide elements of Halstrom wherein the guide element is a rod and the slide element is a hollow tube as taught by Lowe since doing so would serve to maintain the axial alignment of the upper and lower shaped part and prevent relative rotation of the anterior and posterior sections.

4. Claim 16 of the instant application recites wherein the length of the hollow tube is chosen as a function of the desired maximum lateral displacement. At the time of the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Halstrom comprising a slide element

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wherein the length of the hollow tube is chosen as a function of the desired maximum lateral displacement as taught by Lowe in order to maintain the axial alignment of the upper and lower shaped part.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OPHELIA HAWTHORNE whose telephone number is (571)270-3860. The examiner can normally be reached on Monday - Friday, 7:30 AM - 5:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ophelia Hawthorne/
Examiner, Art Unit 3772

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772